IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF MISSOURI
WESTERN DIVISION

DEFLECTO, LLC,	)	
	)	
Plaintiff,	)	
v.	)	Case No. 4:13-cv-00116-ODS
	)	
DUNDAS JAFINE, INC,	)	
	)	
Defendant.	)	
	)	

PLAINTIFF'S MOTION *IN LIMINE* NO. 10 AND SUGGESTIONS IN SUPPORT TO EXCLUDE EVIDENCE PERTAINING TO DR. FADDIS' IMPROPER PROFFER OF ULTIMATE LEGAL CONCLUSIONS AND UNDISCLOSED OPINIONS

Plaintiff Deflecto Inc. ("Plaintiff" or "Deflecto") hereby moves for an order excluding any testimony by Defendant Dundas Jafine's ("Defendant" or "Dundas") engineering expert Dr. Faddis ("Faddis") as to: (1) facts or opinions which are not contained in Faddis' expert reports; (2) ultimate legal conclusions (including willfulness and infringement); and/or (3) legal standards or the patent process at the United States Patent and Trademark Office ("USPTO") ("Plaintiff's MIL No. 10"). Faddis is not qualified to render any opinions on legal topics such as the internal policies and procedures of the USPTO and his opinions are not sufficiently reliable on these topics. In addition, portions of Faddis' opinions constitute clearly impermissible legal conclusions on infringement. Finally, any opinion testimony that is not contained within his expert report should also be excluded for failure to comply with the disclosure requirements of Rule 26(a). In support of this motion, Plaintiff states as follows:

I. INTRODUCTION

Faddis currently teaches computer courses at the University of Kansas and has a background in engineering. He "expect[s] to testify at trial as to [his] opinions as to the alleged infringement of the Asserted Patents and how the Accused Products do not infringe the claims literally or under the doctrine of equivalents." (*See* Exhibit 1 attached hereto, Faddis Infringement Report, dated April 17, 2015, without exhibits, at ¶ 5.) However, infringement is a matter for jury determination, and Faddis' improper legal conclusions of non-infringement should not be permitted. Additionally, Plaintiff anticipates that Defendant will seek to elicit testimony from Faddis regarding the workings of the patent office. Faddis has neither been offered, nor qualified, as an expert witness on this topic, nor has he opined on this topic in his expert reports or testimony; therefore, any such testimony should be barred. Federal Rule of Evidence 701 allows opinion testimony from lay witnesses only if it is "(a) rationally based on the perception of the witness, (b) helpful to a clear understanding of the witness' testimony or the determination of a fact in issue, and (c) not based on scientific, technical, or other specialized knowledge within the scope of Rule 702." Fed. R. Evid. 701. Any conclusions regarding the USPTO by Faddis do not meet these standards.

Furthermore, under the Federal Rules, expert reports are required to contain a complete statement of all opinions to be expressed and the factual basis therefore (Fed. R. Civ. P. 26(a)(2)(B)), and failure to comply with those requirements can result in the Court precluding the use of that witness at trial. Fed. R. Civ. P. 37(c). Likewise, under 8th Circuit precedent, an expert is not allowed to opine on matters not specifically contained in his report. *See Dairy Farmers of America, Inc. v. Travelers Ins. Co.*, 391 F.3d 936, 943-44 (8th Cir. 2004). Faddis' expert reports do not address the patent examination process, nor do they set forth any consideration or opinion relating to the willfulness of Dundas' patent infringement. Any testimony or opinion proffered by Faddis as to the rules and procedures of the USPTO are undisclosed and unreliable, and as such, are inadmissible under both Fed. R. Civ. P. 26 and Fed. R. Evid. 702. Therefore, Defendant should be precluded from offering any testimony or other evidence related to these topics.

II. ARGUMENT AND AUTHORITY

A. Faddis' Opinions Do Not Meet Rule 702 Standards for Admissibility

Federal Rule of Evidence 702 governs the admissibility of expert testimony. It provides:

> If scientific, technical or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case.

Fed. R. Evid. 702.

Although this Court found that Faddis can serve as a technical witness to advise on the technology, he is unqualified to opine on ultimate issues such as infringement and willfulness. (Doc. 175, Court's Ruling on Motion to Exclude Expert Faddis Testimony, pp. 4, 6-7.) Faddis admits in his expert reports that he relied on Defendant's counsel to explain all legal issues to him. (*See* Ex. 1, Faddis Report at ¶ 11 ("In expressing my opinions, I am relying upon certain legal principles that counsel in this case explained to me."); *see also*, Exhibit 2 attached hereto, Faddis Invalidity Report, dated April 17, 2015, without exhibits, at ¶ 59.) It would be highly improper and prejudicial to allow Faddis to then provide his secondhand interpretation of these key legal concepts to the jury. As such, Faddis' testimony should be limited to facts relating to the technical aspects of the Accused Products, and nothing more.

As already recognized by this Court, Defendant is not offering Faddis as a legal expert of any sort. (Doc. 175, p. 3.) Rather, Defendant is offering Faddis as a technical expert, who should not be permitted to make ultimate legal conclusions which would invade the province of the Court to do so. *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1313 (Fed. Cir. 2013); *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1364 (Fed. Cir. 2008).

As such, this Court should exclude any testimony by Faddis as to the ultimate legal conclusions of patent infringement and/or lack of willfulness.

Finally, Defendant failed to designate any expert witness regarding the patent examination process. (*See* Exhibit 3 attached hereto, Def.'s Rule 26 Disclosures, served May 29, 2013.) Plaintiff anticipates that Defendant will attempt to inject a rebuttal of Marshall Honeyman's testimony regarding the patent process into Faddis' testimony at trial. However, as this Court noted in its *Daubert* Order, Faddis is not an attorney and is not qualified as an expert on the patent examination process. (Dkt. No. 175, p. 6.) Faddis may only opine as to technical issues, and not as to the workings of the USPTO, and his testimony should be so limited.

B. Faddis' Disputed Opinions Impermissibly Invade the Province of the Court

An expert witness may not offer legal conclusions. *See Am. Home Assurance Co. v. Fed. Ins. Co.*, No. 06-3237-CV-W-FJG, 2007 WL 1459816, at *4 (W.D. Mo. May 15, 2007) (rejecting proffered expert opinion because it "contains inadmissible legal conclusions"); *see also Hogan v. Am. Tel. & Tel. Co.*, 812 F.2d 409, 411 (8th Cir. 1987) (excluding testimony because "the judge and not a witness is to instruct the factfinder on the applicable principles of law"). "Matters of law are for the trial judge, and it is the judge's job to instruct the jury on them." *S. Pine Helicopters, Inc. v. Phoenix Aviation Mgrs., Inc.*, 320 F.3d 838, 841 (8th Cir. 2003) (*citing United States v. Klaphake*, 64 F.3d 435, 438-39 (8th Cir. 1995)). Where an expert applies the law to the facts of the case to form a legal conclusion, the expert's opinion is inadmissible. *See Employers Reinsurance Corp. v. Mid-Continent Cas. Co.*, 202 F. Supp. 2d 1212, 1219 (D. Kan. 2002) (noting expert opinion that plaintiff breached its duty of utmost good faith and fair dealing "constitutes an impermissible attempt to apply the law to the facts of the case to form a legal conclusion").

In particular, any proffered opinions regarding a lack of willfulness and/or infringement are inadmissible because it is the role of the Court, not the witness, to instruct the jury. *E.g., Clintec Nutrition Co. v. Baxa Corp.*, No. 94C7050, 1998 WL 560284, at *9 (N.D. Ill. Aug. 26, 1998) (precluding expert testimony on the law regarding willfulness); *Oxford Gene Tech., Ltd. v. Mergen Ltd.*, 345 F. Supp. 2d 431, 443 (D. Del. 2004) ("[The plaintiff's patent law expert] will not, however, be permitted to testify as to the legal standard for willfulness. Nor will she be permitted to testify as to whether [the defendant's] behavior met the standard of reasonableness,….").

Through each of the opinions stated in his expert report regarding infringement, Faddis concludes that the Accused Products do not infringe. (*See* Ex. 1, Faddis Infringement Report, at ¶¶ 34, 35, 42, 43, 48, 49, 50, 54, 56, 60, 61, 64, 68, 69, 70, 74, 79, 81, 82, 83, 87, 88, 89, 90, 91, 93, 96, 98, 99, 103, 105, 106, 107, 113, 116, 117, 118, 119, 120, 122, 125, 127, 129, 130, 134, 136, 137, 139.) Faddis simply cannot state "I believe this device does not legally infringe" or the like. He cannot be permitted to invade the province of the Court by offering these opinions to the jury. *See e.g., United States v. Klaphake*, 64 F.3d 435, 438 (8th Cir. 1995) (upholding district court decision excluding testimony by a lawyer as to the legality of a trust agreement because "questions of law are the subject of the court's instructions and not the subject of expert testimony"); *Shaw Group, Inc. v. Marcum*, 516 F.3d 1061, 1068 (8th Cir. 2008) (allowing testimony from expert on ordinary business practices but excluding his testimony as to duty under a contract – a question of law). Moreover, Faddis' conclusory opinions of non-infringement are based solely upon his understanding of legal concepts as (admittedly) explained by Defendant's attorney, and constitute an impermissible attempt to instruct the trier of fact on Faddis' secondhand interpretation of the law. (*See* Ex. 1, at ¶ 11; Ex. 2, at ¶ 59.) Such invasion of the Court's province to instruct the jury should not be tolerated. Faddis' opinions should therefore be excluded as improper legal conclusions.

C. Any Opinions Not Identified in Faddis' Expert Report Should Be Excluded

Finally, Rule 26(a) requires an expert witness to provide a written report containing, *inter alia*, (1) "a complete statement of all opinions the witness will express and the basis and reasons for them," and (2) "any exhibits that will be used to summarize or support them." Fed. R. Civ. P. 26(a)(2)(B). The complete detailed written report must "stat[e] the testimony the witness is expected to present during direct examination." *See* Fed. R. Civ. P. 26 Advisory Committee Notes (attached hereto as Exhibit 4). Rule 37 provides that "[i]f a party fails to provide information . . . as required by Rule 26(a) . . . the party is not allowed to use that information . . . at a trial, unless the failure was substantially justified or is harmless." Fed. R. Civ. P. 37(c)(1).

Plaintiff anticipates that Defendant will attempt to offer Faddis' testimony as to the process undertaken by patent examiners with the USPTO, as well as to the ultimate legal conclusion of a lack of willfulness. Neither of these opinions are stated in his expert reports, and the Court should therefore not permit him to testify regarding these and any other matters not contained in his expert reports. In fact, "willfulness" appears nowhere in his expert reports. Plaintiff would be harmed and the order and efficiency of this case's trial will be disrupted if Defendant is permitted to introduce any untimely or undisclosed exhibits or witness testimony. *See Sappington v. Skyjack Inc.*, No. 04-5076-CV-SW-FJG, 2008 WL 895222, at *7 (W.D. Mo. Mar. 27, 2008) (granting motion *in limine* excluding "[a]ny information, testimony, evidence, or documents not produced in discovery").

Even if Faddis *had* included these additional opinions in his expert reports, they should still be excluded. His purported opinion regarding the legal conclusion of willfulness is unreliable and inadmissible for the reasons set forth *supra*. Faddis is not an attorney, he lacks understanding of the applicable laws and legal principles at issue, and this legal conclusion is not the province of a technical expert. Any testimony on this topic should also be excluded.

There is likewise no basis for Faddis to offer any opinion regarding the patent prosecution process or what an examiner considers. Faddis did not develop or set forth an opinion as to the patent process in his expert reports. (*See* Exs. 1 & 2.) He is not familiar with the customs and practices of the USPTO. Faddis is not qualified to render any purported opinion on this topic; moreover, it would be unreliable.

III. CONCLUSION

WHEREFORE, for the foregoing reasons, Plaintiff Deflecto, LLC respectfully requests the Court exclude the evidence referenced in this Motion, including any testimony by Dr. Faddis as to facts or opinions which are not in his expert reports, any ultimate legal conclusions (including willfulness and infringement), and legal standards or the patent process at the USPTO. Plaintiff further requests all other and further relief as this Court deems just and proper.

Dated: November 27, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the original of the foregoing was served this 27th day of November, 2015, by electronic mail, to the following attorneys of record:

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